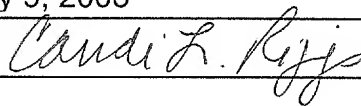
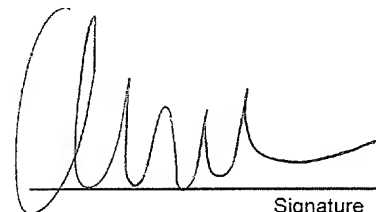


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 9314-58	
<p>I hereby certify that this correspondence is being transmitted electronically to the U.S. Patent and Trademark Office</p> <p>on <u>July 9, 2008</u></p> <p>Signature <u></u></p> <p>Typed or printed name <u>Candi L. Riggs</u></p>		Application Number 10/743,670	Filed 12/22/03
		First Named Inventor Matt Murray	
		Art Unit 2618	Examiner Yuwen Pan
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <div style="display: flex; justify-content: space-between; align-items: flex-start; margin-top: 20px;"><div style="width: 45%;"><p>I am the</p><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. 48,568 Registration number _____</p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></div><div style="width: 50%; text-align: center;"> _____ Signature Elizabeth A. Stanek _____ Typed or printed name 919/854-1400 _____ Telephone number July 9, 2008 _____ Date</div></div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input checked="" type="checkbox"/> *Total of <u>11</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Matt Murray

Serial No.: 10/743,670

Filed: December 22, 2003

For: **MULTI-MODE AUDIO PROCESSORS AND METHODS OF OPERATING
THE SAME**

Confirmation No.: 7610

Group Art Unit: 2618

Examiner: Pan, Yuwen

Date: July 9, 2008

Mail Stop AF

Commissioner for Patents

Box 1450

Alexandria, VA 22313-1450

**REASONS IN SUPPORT OF APPLICANT'S PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program, which was extended until further notice on January 10, 2006.

No fee or extension of time is believed due for this request beyond those requested in papers associated herewith. However, if any fee or extension of time for this request is required, Applicant requests that this be considered a petition therefore. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to our Deposit Account No. 50-0220.

REMARKS

Applicant hereby requests a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action of April 9, 2008 (hereinafter "Final Action"). The Request is provided herewith in accordance with the rules set out in the OG dated July 12, 2005.

Claims 6-9 and 12-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent Publication No. 2004/63456 to Griffin (hereinafter "Griffin") in view of PCT Publication No. WO 1994/11953 to Todter *et al.* (hereinafter "Todter"). *See* Final Action, page 2. Claims 10 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Griffin and Todter in view of United States Patent No. 5,046,103 to Warnaka (hereinafter "Warnaka"). *See* Final Action, page 4. Claims 11 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Griffin in view of Todter and Warnaka in further view of United States Patent No. 5,251,262 to Suzuki (hereinafter "Suzuki"). *See* Final Action, page 5. Applicant respectfully submits that many of the

recitations of the pending claims are not met by the cited references for at least the reasons discussed herein and in Applicant's previously filed Request for Reconsideration of March 19 2008. Furthermore, Applicant submits that the Office Action of December 21, 2007 and/or , the Final Action have not shown that the claims are obvious in view of the cited references. Therefore, Applicant respectfully requests review of the present application by an appeal conference prior to the filing of an appeal brief. In the interest of brevity and without waiving the right to argue additional grounds should this Petition be denied, Applicant will only discuss the recitations of the independent Claims 6 and 12.

Independent Claim 6 recites:

A mobile terminal comprising:
a housing;
a microphone positioned in the housing;
a speaker positioned in the housing remote from the microphone; and
a multi-mode audio processor circuit configured to apply noise cancellation to first and second microphone inputs thereof, the first microphone input being coupled to the microphone and the second microphone input being coupled to the speaker,
wherein the speaker comprises a transducer and wherein the multi-mode audio processor circuit is configured to transmit sound from the transducer in a first mode of operation and to generate a composite audio signal from sound energy received by the microphone and the transducer in a second mode of operation.

Applicant submits that at least the highlighted recitations of independent Claim 6 are neither disclosed nor suggested by the cited combination for at least the reasons discussed herein.

The Final Action admits that nothing in Griffin teaches the highlighted recitations of Claim 6. *See* Final Action, page 3. However, the Final Action points to Todter as providing the missing teachings. *See* Final Action, page 3. Applicant respectfully disagrees. Applicant respectfully submits that there is no motivation to combine Griffin and Todter as suggested in the Final Action for at least the reasons discussed herein.

In particular, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U. S. 1, 15 (2007)(emphasis added). A corollary principle is that, when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be unobvious. *Id.* at 12. If a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Id.* at 13. A Court must ask whether the improvement is more than the predictable use of prior art elements according to

their established functions. *Id.* at 13. **When it is necessary for a Court to look at interrelated teachings of multiple patents, the Court must determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.** *Id.* at 14 (emphasis added).

The Final Action states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Todter with Griffin's device to implement active noise attenuation systems **without the need to use a microphone.**

See Final Action, page 3 (emphasis added). Griffin discusses first 12 and second communication modules 14 configured to communicate so as to allow, for example, hands-free operation of one of the communication modules. *See* Griffin, Abstract and paragraph 27. Figure 4 of Griffin illustrates a communication module configured to be received in a user's ear for hands-free operation of a second communication module. *See* Griffin, paragraph 32. As discussed in Griffin, the second communication module 14 may include a microphone 14d, a speaker 14a and "preferably includes a noise cancellation circuit with a background noise microphone 48." *See* Griffin, paragraphs 32-33. The noise cancellation circuit may be included because, as discussed in Griffin, the microphone 14d may pick up more than the user's voice, thus, the noise cancellation circuit to filter out background noise, *i.e.*, noise other than the user's voice.

Todter discusses an active noise cancellation system as stated in the title. In particular, as discussed in Todter, a bilateral transducer is provided that both senses ambient noise and produces acoustic noise. *See* Todter, Abstract. Thus, the bilateral transducer taught by Todter replaces the microphone and the speaker provided in conventional noise cancellation systems. *See* Todter Abstract.

Applicant respectfully submits that there is no motivation to combine the communication device of Griffin with the active noise cancellation system of Todter. The reasoning provided in the Final Action is based on hindsight in view of Applicant's disclosure. As discussed above, a patent composed of several elements is **not** proven obvious merely by demonstrating that each of its elements was, independently, known in the prior art. There must be an apparent reason to combine the known elements in the fashion claimed. As discussed above, Griffin already teaches a noise cancellation filter in the second communication device and, thus, one of skill in the art would have no reason to look for the system provided in Todter. Accordingly, nothing in the Final Action or the cited art would

motivate a person of skill in the art to combine the cited references without using Applicant's disclosure as a road map. For at least these reasons, Applicant respectfully submits that independent Claim 6 and the claims that depend therefrom are patentable over the cited combination.

Furthermore, even if combined, as discussed above, Todter teaches replacing the speaker and the microphone with the bilateral transducer. If the microphone 14d and the speaker 14a of Griffin were replaced with the bilateral transducer of Todter, the combination would not teach a microphone positioned in the housing; a speaker positioned in the housing remote from the microphone; and a multi-mode audio processor circuit as recited in Claim 6. Accordingly, Applicant respectfully submits that independent Claim 6 and the claims that depend therefrom are patentable over the cited combination for at least these additional reasons.

Responsive to Applicant's arguments, the Final Action states:

...The examiner respectfully disagrees since one ordinary skill in the art would look for improvement of noise cancellation or control system that only utilize one bilateral transducer/speaker and corresponding circuit in stead of one speaker and one noise microphone in which would require more occupied space in a limited hands free earphone and increase the cost...

See Final Action, page 2 (emphasis in original). Applicant respectfully submits that the Examiner cannot justify combination of references based on unsupported speculation about what one of skill in the art would "look for." Furthermore, as discussed above, even if combined, the combination of Todter and Griffin does not disclose or suggest the recitations of Claim 6 set out above. Accordingly, Applicant respectfully submits that independent Claim 6 and the claims that depend therefrom are patentable over the cited combination for at least these additional reasons.

Furthermore, independent Claim 12 recites:

A mobile terminal comprising a multi-mode audio processor circuit operatively associated with a transducer, **the multi-mode audio processor circuit being configured to operate the transducer as a speaker during a first mode of operation and a microphone during a second mode of operation.**

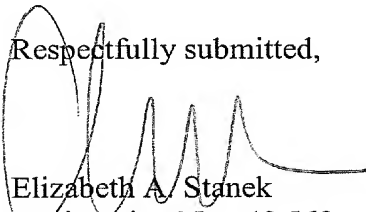
Applicant respectfully submits that at least the highlighted recitations of Claim 12 are neither disclosed nor suggested by the cited combination for at least the reasons discussed herein. The Final Action points to the same portions of the references cited as teaching the recitations of Claim 6 as teaching the recitations of Claim 12. See Final Action, page 3. Thus,

In re: Matt Murray
Serial No.: 10/743,670
Filed: December 22, 2003
Page 5 of 5

Applicant submits that independent Claim 12 and the claims that depend therefrom are patentable over the cited combination for at least the reasons discussed above with respect to Claim 6.

Accordingly, for at least these reasons, Applicant respectfully submits that the Office Actions fail to show that the claims of the present application are obvious in view of the cited references and, therefore, requests that the present application be reviewed and that the rejections be reversed by the appeal conference prior to the filing of an appeal brief.

Respectfully submitted,

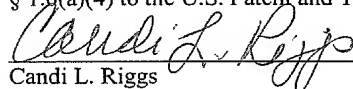


Elizabeth A. Stanek
Registration No.: 48,568

USPTO Customer No. 54414
Myers Bigel Sibley & Sajovec
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: 919/854-1400
Facsimile: 919/854-1401

CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on July 9, 2008.



Candi L. Riggs